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obvious, based on a Hanna Reference. Claim 1 recites:

1. In connection with operation of a system of ATMs, each of which contains at least one computer, a method comprising the following steps:

- a) identifying low-stocked ATMs, which require replenishment of currency;
- b) causing replenishment of currency in low-stocked ATMs to occur;
- c) receiving replenishment signals from the replenished ATMs; and
- d) using the replenishment signals, and without using communications from parties performing the replenishment, preparing one, or more, reports concerning the ATMs replenished.

The Office Action admits that claims 1(c) and (d) are absent from Hanna. The Office Action relies on the "Reconciliation Report" of Hanna's column 36 to show these claim recitations. However, several problems exist in this reliance.

Problem 1

The "replenishment signals" of claim 1(c) have not been shown in Hanna. MPEP 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

Applicant requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. §

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132, that the PTO specifically identify the "replenishment signals" in the prior art.

Problem 2

The "reconciliation report" of Hanna does not correspond to the report of claim 1(d). Several reasons support this conclusion.

REASON 1

One reason is that Hanna's reconciliation report is given to a **depositor**, that is, for example, to a merchant who makes a "bag deposit" of cash and coins. There is no "replenishment" involved in, or reported by, the "reconciliation report." Hanna's Figure 57 provides an example of such a report.

REASON 2

A second reason is that claim 1(d) states that the "report" is prepared "using" the "replenishment signals." (For example, the replenishment signals may state that 1,000 ten dollar bills were inserted into an ATM.)

Applicant can see no usage of any "replenishment signals" in Hanna's "reconciliation report." Consequently, Applicant requests that a "report" prepared "using" the "replenishment signals" be identified in Hanna.

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REASON 3

Claim 1(d) recites "reports concerning the ATMs replenished." Since that "report" is prepared "using" the "replenishment signals," plainly, that "report" contains information about the "replenishment." (If the PTO disagrees, then Applicant requests that the PTO explain how the "report" can be prepared "using" "the replenishment signals" and yet contain no information about the "replenishment.")

Thus, the claimed "report" contains information about the replenishment. Hanna's "reconciliation report" contains no such information. Hanna's Figure 57 provides an example of a "reconciliation report." Plainly, it refers to information relating to a transaction undertaken by a customer. That is not a replenishment.

REASON 4

It could be argued that Hanna's customer, in depositing money, acts to "replenish" the ATM. However, several problems exist in this interpretation, primarily from the facts that such an interpretation is not consistent with claims 1(a) and (b). These problems will not be further discussed, because significant problem seems more persuasive.

The significant problem lies in the fact that, if the customer is treated as performing the "replenishment," then claim 1(d) is

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not found. A primary reason is that claim 1(d) states that the report is prepared "without using communications from parties performing the replenishment." In the present case, that means "without communications from (Hanna's) customer."

But Hanna's "reconciliation report" contains material which was supplied by the customer. For example, the "reconciliation report" 450 in his Figure 57 indicates amounts of "currency accepted." At least some of those amounts were keypunched by customers who deposited bags of currency. (Column 31, lines 60 - 63; column 8, lines 36 et seq.; column 21, line 30 et seq.; column 30, line 40 et seq.)

That makes perfect sense. Hanna discusses a system in which a customer deposits a "bag" of money. The customer keys in the amount of the deposit.

Therefore, the customer cannot be the party performing the "replenishment" of claim 1. The customer provides part of the content of the "reconciliation report" (amount of cash in the bag). That is contrary to the claim.

The preceding discussion indicates that several recitations of claim 1 have not been shown in the prior art. Thus, the 103-rejection should not stand.

Additional Points

The Office Action, page 3, bases its rejection on the

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assertion that "all types of transactions are reported to a remote computer." Applicant requests that this statement be justified. One reason is that it seems self-evident that some transactions would **not be** so reported. For example, assume a person entered a passcard at an ATM, and then entered an incorrect PIN, so that the person was rejected. Is that reported to a "remote computer," or simply recorded as a statistic at the ATM and kept there ?

Applicant requests that the PTO's assertion be justified.

No Teaching for Modification of Hanna Shown

The Office Action asserts that "The motivation" for modifying Hanna to show claim 1 is found in recording "the time, the deposited replenishment amount etc." (Page 3, end of first paragraph.)

However, with one exception, Hanna **by himself** already records those elements. (See Figures 57 - 59.) The presence of those elements in Hanna is not a motivation to modify Hanna to show claim 1.

The "exception" is "deposited replenishment amounts." For Hanna to show that, the "deposited replenishment amounts" must be made available for dispensing to other customers, or otherwise qualify as a "replenishment." (Because it is the stock of money which is dispensed to customers which is "replenished.")

Applicant cannot find such "replenishment" in Hanna. The

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amounts deposited appear to be collected by the bank, and then processed in the normal manner. That is not "replenishment."

Claim 2

Dependant claim 2 is considered patentable, based on its parent.

Claim 3

Claim 3 recites:

3. Method according to claim 2, wherein the replenishment signals indicate contact with an ATM by a party other than a customer in the normal course of business.

Applicant requests that the "party other than a customer in the normal course of business" be identified in Hanna.

RESPONSE TO REJECTION OF CLAIM 4

Claim 4 recites:

4. Method according to claim 3, wherein entry into an ATM by a burglar causes a replenishment signal to occur.

The Office Action asserts that Ross, column 7, bottom, and column 8, top, detects a "low state" of a cassette, and notifies the police in response. Applicant submits that Ross does not show

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that.

Ross states that a "low state" detection enables replenishment of the cassette, but does not state that the police are called upon that event (detection of a low state).

Further, that interpretation of Ross appears to make no sense. Eventually, all cassettes will reach a "low state" on a regular basis, with no robberies occurring. Why would the police be called ?

Further still, Ross expressly states that the police are called in completely different circumstances, which he describes in column 8, line 14 et seq.

Therefore, even if the references are combined, the features which the PTO asserts to be found in Ross are not found.

In addition, no teaching has been provided for combining the references. The rationale is that the combination provides a system wherein

- 1) a theft reduces the stock of currency in an ATM,
- 2) that reduction is detected, and results in a call for replenishment, and
- 3) the replenishment allows continued business-as-usual.

However, several problems exist in this rationale.

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Problem 1

The **combination** of references is not needed to attain the goal of the rationale. Any ATM which contains

- 1) a detector to detect amount of currency present and
- 2) a notifier to call for replenishment when the detector deems it necessary

will attain that goal. The goal is to replenish the currency after a theft.

There is no need to combine Hanna with Ross to attain that goal.

Problem 2

The PTO presumes that the theft does not damage the ATM, and that all the sensors remain functional after the theft. That is highly doubtful, or at least has not been shown.

Problem 3

In actual practice, business-as-usual would probably not be desired after a theft. The occurrence of the theft indicates that a failure in security has occurred. The natural tendency is to analyze the problem, and see whether the system needs to be re-designed. The natural tendency is not to re-fill the ATM immediately.

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Problem 4

Applicant respectfully submits that the rationale is somewhat ridiculous. A theft occurs. A sensor detects the depletion of currency, and calls for replenishment. Replenishment occurs.

Won't the thief figure this out, and steal the new money ?
Won't the thief camp out, waiting for replenishments, and continually steal them ?

Additional Point

MPEP § states 706.02(j):

Contents of a 35 U.S.C. 103 Rejection

. . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . .

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

Ross, at the very end of his Specification, states that he

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uses a microphone to detect a burglary, or an unauthorized person attempting to enter his safe. Applicant fails to see how a microphone could do that. Thus, Applicant requests that the PTO show likelihood of success, and explain how a microphone is used to detect Ross's burglar.

RESPONSE TO REJECTION OF CLAIM 5

The operation of claim 5 is simply not found in the references, even if combined. Claim 5 recites:

5. In the operation of a system of ATMs, a method comprising:

- a) maintaining a security system within each ATM, which
 - i) detects entry into the ATM, and
 - ii) issues an entry signal in response; and
- b) scheduling replenishment of a group of ATMs during a time period; and
- c) when entry signals are received from ATMs within the group, during the time period, designating the corresponding ATMs as having been replenished in currency.

Claim 5 states, in effect, "If you receive a burglar alarm from an ATM in the 'time period,' assume that the ATM is being replenished and not burglarized." That operation, or reasoning, is nowhere found in the references, even if combined.

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No teaching has been given for combining the references. The rationale, given on page 5, is that the references are combined in order to rank the ATMs in order of priority, and then select a route to reach them in that order. Applicant cannot find that concept in the references, and requests that it be identified.

Further, Applicant fails to see how, even if that concept (ranking and routing) is found, how that leads to claim 5.

The Office Action, page 5, states:

When a detection of replenishment is made at one of the ATMs, a low stocked-signal would have been sent to a remote location.

Applicant cannot locate that concept in the references, and requests that it be identified.

The Office Action, page 4, states:

The step of when entry signals are received from an ATM during the time period designating the corresponding ATMs as having been replenished in currency would have been obvious . . . because replenishment of the ATM would have been made during that period of time.

Applicant points out that this statement employs circular logic. It states, in effect, that

ATMs issue signals indicating replenishment during the time period because they were replenished during the time period.

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That is circular logic. Circular logic is not allowed.

In addition, Applicant cannot locate such replenishment signals in the references, and requests that they be identified.

The Office Action, page 4, bottom, asserts that a report is obvious. Applicant fails to understand the relevance of this assertion, since claim 5 discusses no report.

RESPONSE TO REJECTION OF CLAIMS 6 - 9

The Office Action asserts that Hanna, column 13, lines 35 - 67 and column 30, lines 14 - 39, shows estimating amount of currency in an ATM without actually measuring the amount. However, neither passage states that.

Point 1

The former passage, when read with the paragraph preceding it, indicates that "messages" (such as the need for replenishment) are generated by a "terminal processor 74" and are based on conditions in "transaction function devices." (Column 13, lines 16 - 17.) The "terminal processor 74" is contained within ATM 10. Thus, the passage relied on by the PTO states that the "terminal processor" learns of the need to replace cash. (Column 13, line 42.)

Thus, it appears that the ATM generates messages indicating a need for replenishment, contrary to the claim passage in

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question, which recites absence of measurement at the ATM.

Point 2

Even if Hanna does show this claim recitation, Hanna also shows a contrary idea, namely, sensing amounts of currency at the ATM. Column 30, lines 31 - 32, states that sensors at the ATM can detect levels of currency. This creates two problems in the rejection.

One problem is that the passage just cited is contained within the PTO's larger passage cited in support of the PTO's proposition (ie, column 30, lines 14 - 39). But that passage contradicts the PTO's proposition. Thus, the PTO has defeated its own proposition.

The second problem is that, if Hanna also shows estimating currency amounts without measuring, then Hanna shows two things:

- 1) estimating without measuring, and
- 2) measuring directly.

The PTO relies on the former, to combine with Ross. However, no teaching has been given for selecting the former over the latter. A teaching is required.

Point 3

The Office Action, page 6, paragraph beginning with "Recording the times of . . ." asserts that several elements are "obvious." However, that is insufficient. Those elements must be shown in the

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prior art. If it is being asserted that those elements are "inherent" in Hanna, then MPEP § 2112 applies, which states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE
TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Point 4

Further, section 103 requires that the "subject matter as a whole" of a claim must be obvious. Asserting that individual elements are "obvious" does not meet this test.

From another point of view, if in the paragraph in question (ie, that beginning with "Recording the times of . . ."), the PTO means to say that the elements in question were "well known" rather than "obvious," another problem arises. Even if those elements are "well known," that fact, at best, merely removes the need to **show** the elements in the prior art, as in a printed publication. Nevertheless, a teaching is still required in favor of combining those elements together.

Point 5

The PTO asserts that Ross shows claim 6(g), which recites:

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g) ascertaining whether the signals were issued by an ATM within the subset.

Applicant cannot locate that recitation in Ross, and requests that it be specifically identified. 37 CFR § 1.104(c)(2) states:

. . . the Examiner must cite the best references at his . . . command.

When a reference is complex or shows or describes inventions other than that claimed by the applicant, **the particular part relied on must be designated as nearly as practicable.**

The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

In this connection, the undersigned attorney points out that he read Ross, and found Ross to be concerned with using microphones to "listen" to machinery operating within an ATM, to detect strange sounds indicating malfunctions in the machinery. The vast majority of Ross is devoted to discussions on how his microphones accomplish his goal.

Given that fact, the undersigned attorney fails to see why Ross would discuss the subject matter of claim 6(g). Thus, it is requested that claim 6(g) be identified in Ross.

Point 6

The Office Action asserts that the adjusting process of claim

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6(g)(ii) is "obvious," based on both Ross and Hanna. However, claim 6(g) states that the "ascertainment" step induces the "adjustment" step. Since, as just explained, the "ascertainment" step is absent, Applicant submits that the "adjustment" step is also absent. Or at least the PTO has not explained this. Further, claim 6(g) recites a condition, and two actions, depending on whether the condition occurs. This alternate operation has not been shown in the references, nor has it been alleged to be present. Thus, as a matter of procedure, the rejection must fail.

Point 7

Applicant repeats that, in the rejection of claim 6, the PTO repeatedly asserts that several elements are "obvious" based on the references. That is not the standard for rejection. The standard is whether the "subject matter as a whole" is obvious.

From another point of view, the PTO cites Hanna to show some elements of claim 6. Then it asserts that other elements four other elements (call them A, B, C, and D) are "obvious" (or "automatic"). However, that does nothing more than assert that

Hanna-plus-element-A is obvious

Hanna-plus-element-B is obvious

Hanna-plus-element-C is obvious and

Hanna-plus-element-D is obvious.

That is, the PTO has only asserted that four **subsets** of claim 6 are

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obvious. That does not show that the "subject matter as a whole" is obvious.

By analogy, assume that an inventor invents a new car in which

-- the engine gets 200 miles per gallon

and

-- the brakes will decelerate from 60 mph to
zero in ten feet.

That inventor claims car-plus-brakes-plus-engine.

If the PTO shows that

- 1) car-plus-brakes is obvious, and
- 2) car-plus-engine is obvious,

nevertheless, that does not show that car-plus-brakes-plus-engine is obvious. That merely shows that two **SUB-SETS** of the invention are obvious.

In this car-example, and in the present invention, the invention, as a minimum, is the combination of at least two sub-sets. That combination has not been shown to be obvious. This applies to other claims.

The preceding applies to claim 8. In addition, Applicant requests that the "report" of claim 8, which is "based on the signals" be identified in the references.

Claim 7

The Office Action asserts that the references show a